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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/588,869	05/10/2007	Wayne Gregory Mitchell	WAT-PT006	4080
3624 7590 06/09/2009 VOLPE AND KOENIG, P.C. UNITED PLAZA, SUITE 1600 30 SOUTH 17TH STREET PHILADELPHIA, PA 19103			EXAMINER FIORELLO, BENJAMIN F	
			ART UNIT 3672	PAPER NUMBER
			MAIL DATE 06/09/2009	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/588,869

**Applicant(s)**

MITCHELL, WAYNE GREGORY

**Examiner**

BENJAMIN FIORELLO

**Art Unit**

3672

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4, 10-12 and 14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 10-12 and 14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 August 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB08)
- Paper No(s)/Mail Date 08/10/2006.

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Specification***

1. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

2. The abstract of the disclosure is objected to because the content must be a series of sentences instead of one long sentence. Correction is required. See MPEP § 608.01(b).
3. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The title is objected to because it is not commensurate with the claimed invention, i.e. does not recite "A method and apparatus".

### ***Claim Objections***

4. Claim 12 is objected to under 37 CFR 1.75(c) as being in improper form because its parent claim has been cancelled.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-4 are rejected under 35 U.S.C. 102(b) as being anticipated by Martinez (4,723,870).

With regard to claim 1, Martinez discloses an apparatus comprising:

at least one disc member (18) having a plurality of teeth like formations (20) around its periphery and mount means (16) for said at least one disc member permitting said disc member to roll through fine particulate material in a trench (col. 2, lines 47-50), said mount means including connection means (12, 14) enabling said apparatus to be connected to machinery for moving the apparatus along said trench (col. 4, lines 6-15).

With regard to claim 2, Martinez discloses the mount means include a shaft (axle 16) interconnecting said disc members.

With regard to claim 3, Martinez discloses the spacing distance between said disc members is selectably adjustable (Martinez discloses the wheels are held in place by a locking means 30 (col. 4, lines 36-41) and although Martinez does not explicitly state adjusting the spacing between the wheels, it is inherent that one may shift the spacing of the wheels since the locking mechanism 30 can be utilized at any place about the axis 16).

With regard to claim 4, Martinez discloses the teeth like formations have a rectangular shape (col. 4, lines 26-28).

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1—12 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wiker et al. (WO 97/44532) in view of Martinez (4,723,870) and Hatch (4,714,381).

With regard to claim 10, Wiker discloses a method comprising:

depositing fine particulate bedding material (3) into the trench for use as bedding under an elongated member (5),

placing a first apparatus in the trench (fig. 4), said first apparatus having spaced side wall means (fig. 7, walls 12,13) supports by support means (16, 17) resting on a base of said trench with side wall means located adjacent respective side walls of said trench (fig. 4), said first apparatus also a transverse wall (11) member having a lower edge spaced upwardly from the base of said trench (fig. 7),

moving said first apparatus along said trench while said transverse wall member spreads fine particulate material and the lower edge of said transverse wall means provides a level surface for said material (abstract),

laying elongated pipe members on said level surface of said material (fig. 6),

depositing a further quantity of fine particulate material (4, Wiker discloses coarse material 4, but it is well known that fine material and coarse material are well known expedients) into said trench such that said further quantity at least partially fill the space between said elongated member and the side wall of the trench (fig. 3).

Wiker fails to disclose passing a second apparatus along said trench and fails to explicitly state back filling the trench.

Martinez discloses passing an apparatus along a trench (col. 2, lines 44-46), said apparatus including at least one disc member (18) having a plurality of teeth like formations (20) around its periphery whereby each disc member rolls through a material, and although not explicitly, is clearly capable of rolling with a disc on each side of an elongated member.

Hatch discloses back filling the trench (fig. 1).

It would have been obvious to one of ordinary skill in the art to modify the method of Wiker to include rolling a compaction device of the fill in order to compact the soil and create a sturdy surface.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the method of Wiker and backfill the trench in order to provide a level surface area.

With regard to claim 11, Hatch discloses the backfill is previously excavated material from a trench (see fig. 1).

With regard to claim 12, as best understood, Wiker, as modified, fails to explicitly state the fine particulate material is provided to the trench site from a remote source.

However, the examiner takes OFFICIAL NOTICE in stating it is well known to import fill material from a remote source depending on the design parameters at hand and the soil condition at any given site.

With regard to claim 13, although not explicitly stated, it is clearly obvious that the device of Martinez may be passed along the soil just one time.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BENJAMIN FIORELLO whose telephone number is (571)270-7012. The examiner can normally be reached on Monday to Thursday from 7:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bagnell can be reached on (571)272-6999. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/TARA MAYO-PINNOCK/  
Primary Examiner, Art Unit 3671

BF  
06/05/2009